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Docket No.: 193378US0X

GP 1742 #



ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

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RE: Application Serial No.: 09/610,343
Applicants: Mohamed BOUZEKRI
Filing Date: JULY 3, 2000
For: STEEL SHEET WITH LOW ALUMINUM CONTENT FOR
CONTAINERS
Group Art Unit: 1742
Examiner: IP, S

SIR:

Attached hereto for filing are the following papers:

Petition to the Commissioner Under 37 CFR §1.144
Copy of Response filed June 27, 2001
Copy of Office Action mailed June 19, 2001
Copy of Cited Decision

Our check in the amount of \$130.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

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DOCKET NO.: 193378US0X



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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
MOHAMED BOUZEKRI : EXAMINER: IP, S.
SERIAL NO: 09/610,343 :
FILED: JULY 3, 2000 : GROUP ART UNIT: 1742
FOR: STEEL SHEET WITH LOW :
ALUMINUM CONTENT FOR
CONTAINERS

PETITION TO THE COMMISSIONER UNDER 37 C.F.R. §1.144

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

Applicant respectfully petitions the Commissioner to review and withdraw the Restriction Requirement of June 19, 2001 in the above-mentioned application. The facts of this case are as follows:

A Restriction Requirement was mailed in this application on June 19, 2001, requiring restriction under 35 U.S.C. §121 between:

Group I: Claims 1-8, drawn to a process for manufacturing a steel strip, and

Group II: Claims 9-12, drawn to a steel product.

The Examiner based the restriction on MPEP §806.05(f) and stated that the product, as claimed, can be made by another and materially different process with ultra-low C steel.

A copy of the Office Action mailed June 19, 2001, is attached herewith.

A response was timely filed on June 27, 2001 electing, with traverse, Group II, Claims 9-12. A copy of the response as filed June 27, 2001, is attached herewith.

The Restriction Requirement was properly traversed on the grounds that the carbon content of the claimed steel strip and that of the steel strip used in the claimed process are exactly the same. Accordingly, the claimed steel strip cannot be made by a process with ultra-low C steel.

In the Examiner's action of September 14, 2001 it was stated that the argument in the response of June 27, 2001 was not persuasive, because as evidence Applicant did not submit a clear admission that the unpatentability of Group I invention would imply the unpatentability of the Group II invention, citing In re Lee, 199 USPQ 108 (Cmr. Pats. 1978). A copy of the above-cited decision is attached herewith.

However, there is nothing in the above-cited decision that sets forth a requirement that Applicant submit a clear admission that the unpatentability of the Group I invention would imply the unpatentability of the Group II invention. All that is stated on page 109, [2] is the following: "In view of the office policy with respect to Restriction Requirements set forth above, the closeness of the 'patentably distinct' question, and Petitioners' clear and unambiguous admission that the inventions are not patentable over each other, it is concluded that the public interest is better served by withdrawing the Restriction Requirement and permitting both inventions to be prosecuted in the same application." There is nothing in this statement that sets forth a requirement in a traversal of a Restriction Requirement to make the above-discussed admission. Further, it is clear from a reading of Claim 1 that it is not an obvious process of using a steel strip of Claim 1 to produce a steel strip of Claim 9 which is a steel strip of the same composition of Claim 1 and produced by the process of Claim 1. There is no prior art cited in the case that shows the process of Claim 1 differs from the prior art only by the recitation of the specific composition of matter recited in Claim 9 and that the

claimed process would be an obvious use of the claimed composition within the meaning of 35 U.S.C. §103, as was the case in the above-cited decision.

Applicant respectfully petitions the Commissioner to review and withdraw the Restriction Requirement of June 19, 2001 in view of the above discussion.

An early and favorable indication of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 09/610,343 | 07/03/00 | BOUZEKRY | 193378U855X |

022850 IM52/0619
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EXAMINER

IP, S

ART UNIT PAPER NUMBER

1742

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DATE MAILED: 06/19/01

RD 7-19-01

Please find below and/or attached an Office communication concerning this application or proceeding.

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Commissioner of Patents and Trademarks

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JUN 20 2001

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Office Action Summary

| | | | |
|-----------------|----------------|--|--|
| Application No. | Applicant(s) | | |
| Examiner | Group Art Unit | | |

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE NOV 16 2001 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ **Response** to communication(s) filed on 11/16/01.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☐ Claim(s) 1-12 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1-12 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- *Certified copies not received: _____.

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-8 are, drawn to a process for manufacturing a steel strip, classified in class 148, subclass 601+.

II. Claims 9-12 are, drawn to a steel product, classified in class 148, subclass 328+.

2. The inventions are distinct, each from the other because:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process with ultra-low C steel.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination

Serial No: 09/610,343
Art Unit: 1742

-4-

FAX in Technology Center 1700, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communication with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.



SIKYIN IP
PRIMARY EXAMINER
ART UNIT 1742

S. Ip
June 19, 2001

DOCKET NO.: 193378US0X



COPY

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:
Mohamed BOUZEKRI

:

: GROUP ART UNIT: 1742

SERIAL NO.: 09/610,343

:

FILED: July 3, 2000

: EXAMINER: S. IP

FOR: STEEL SHEET WITH LOW ALUMINUM CONTENT FOR CONTAINERS

RESPONSE TO RESTRICTION REQUIREMENT

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

Responsive to the Official Action dated June 19, 2001, Applicants elect, with
traverse, Group II, Claims 9-12.

REMARKS

The Office has required restriction in the present application as follows:

Group I: Claims 1-8, drawn to a process for manufacturing a steel strip; and

Group II: Claims 9-12, drawn to a steel sheet.

Applicants elect, with traverse, Group II, Claims 9-12.

Restriction is only proper if the claims of the restricted groups are either independent or patentably distinct. The burden of proof is on the Office to provide reasons and/or examples to support any conclusion with regard to patentable distinctness. MPEP §803.

Applicants respectfully traverse the Restriction Requirement on the grounds that no adequate reasons and/or examples have been provided to support a conclusion of patentable

distinctness between the identified groups or shown that a burden exists in searching all the claims.

In regard to Groups I and II, the Office has characterized the relationship between these two groups as "process of making and product made." Citing MPEP §806.05(f), the Office suggests the product as claimed can be made by another and materially different process "with ultra-low C steel". However, this statement is not correct. The carbon content of the claimed steel strip and that of the steel strip used in the claimed process are exactly the same. Accordingly, the claimed steel strip can not be made by a process with ultra-low C steel. Accordingly, Applicants respectfully submit that the Restriction Requirement is unsustainable, and it should therefore be withdrawn.

Further, Applicants respectfully traverse the Restriction Requirement on the grounds that the Office has not shown that a burden exist in searching all of the claims. The Office cannot reasonably assert that a burden exists in searching only two subclasses.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement. Withdrawal of the Restriction Requirement is respectfully requested.

Finally, Applicants note that MPEP §821.04 states, "if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined." Applicants respectfully submit that should the elected group be found allowable, non-elected claims 1-8 should be rejoined.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice of such action is earnestly solicited.

Respectfully submitted,

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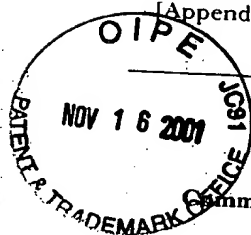


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these defendants are concerned. In view of the Court's conclusions on the merits, obviously no award of attorney's fees against the defendants is warranted.

The request for attorney's fees accordingly will be denied.
[Appendix omitted.]



Commissioner of Patents and Trademarks

In re Lee, et al.

Opinion dated May 26, 1978

PATENTS

1. Double patenting — In general (§33.1)

Joinder of invention — In general (§42.1)

Pleading and practice in Patent Office — In general (§54.1)

It is Patent and Trademark Office policy, as set forth, for example, in Manual of Patent Examining Procedure 803.01 and 804.01, that it is important from standpoint of public interest that no restriction requirements be made that might result in issuance of two patents for same invention; nullification of double patenting as ground of rejection provided for in third sentence of 35 U.S.C. 121 imposes heavy burden on Patent Office to guard against erroneous restriction requirements where claims define essentially same invention, and which might result in more than one patent for essentially same invention with attendant prolongation of patent monopoly.

2. Joinder of invention — Tests of (§42.9)

Pleading and practice in Patent Office — In general (§54.1)

It is necessary to show that inventions that are "related" are "distinct" to support restriction requirement; MPEP 802.01 defines "distinct" as necessitating that inventions, inter alia, be patentable over each other; Manual provides no guidelines on how to determine if two "related" inventions are patentable over each other.

3. Joinder of invention — Tests of (§42.9)

Pleading and practice in Patent Office — In general (§54.1)

Term "independent and distinct," as found in 35 U.S.C. 121, is not improperly interpreted by Commissioner's instructions to examiners that do not recite that inventions must be both "independent" and "distinct" to be properly restrictable.

Particular patents — Silanol Compositions

Lee, et al., Stable Silanol Compositions and Process for Making Them, restriction requirement withdrawn.

Application for patent of Henry L. Lee, Jr., et al., Serial No. 662,226, filed Feb. 27, 1976. On applicants' petition to withdraw restriction requirement, and to revise Commissioner's instructions with respect to restriction requirements. Petition granted in part and denied in part.

James R. Larami, and Irons & Sears, both of Washington, D.C., for petitioners.

Feldman, Deputy Assistant Commissioner for Patents.

This is a decision on the petition, filed March 7, 1978, to the Commissioner under 37 CFR 1.181 requesting:

1. Review of the decision of the Group Director of May 27, 1977, denying a petition to withdraw a restriction requirement under 37 CFR 1.144; and,
2. Reconsideration of the decision of the Deputy Assistant Commissioner for Patents of December 20, 1977, denying a request that the Commissioner revise his instructions to examiners generally with respect to restriction requirements.

[1] With respect to the first request, it is Office policy, as set forth, for example, in MPEP 803.01 and 804.01 that it is important from the standpoint of public interest that no restriction requirements be made which might result in the issuance of two patents for the same invention. The nullification of double patenting as a ground of rejection provided for in the third sentence of 35 USC 121 imposes a heavy burden on the Office to guard against erroneous requirements for restriction where the claims define essentially the same invention and which if acquiesced in, might re-

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f invention — Tests of

and practice in Patent Office general (§54.1)

dependent and distinct," as 35 U.S.C. 121, is not improperly by Commissioner's instructions that do not recite that must be both "independent" and "distinct" to be properly restrictable.

patents — Silanol Composi-

Stable Silanol Compositions or Making Them, restriction withdrawn.

for patent of Henry L. Lee, et al No. 662,226, filed Feb. 27, 1977, Petitioners' petition to withdraw requirement, and to revise Commissioner's instructions with respect to requirements. Petition granted and denied in part.

Pratt, and Irons & Sears, Washington, D.C., for Petitioners.

Deputy Assistant Commissioner of Patents.

Decision on the petition, filed May 27, 1977, to the Commissioner of Patents, 1.181 requesting: That the decision of the Group of May 27, 1977, denying a petition to withdraw a restriction requirement under 37 CFR 1.144;

Consideration of the decision of the Deputy Assistant Commissioner of Patents of December 20, 1977, denying request that the Commissioner revise his instructions to examiners with respect to restriction requirements.

With respect to the first request, it is as set forth, for example, in 37 CFR 1.144 and 804.01 that it is important that public interest in the issuance of two patents for the same invention. The nullification of patenting as a ground of invalidity provided for in the third sentence of 35 USC 121 imposes a heavy burden to guard against erroneous grants for restriction where the inventions are essentially the same invention if acquiesced in, might re-

sult in more than one patent for essentially the same invention with attendant prolongation of patent monopoly.

[2] In the situation where the inventions in question are "related", it is necessary, to support a restriction requirement, to show that they are "distinct". MPEP 802.01 defines "distinct" as necessitating that the inventions, inter alia, be patentable over each other. The Manual provides no guidelines on how to determine if two "related" inventions are patentable over each other. In the instant application, it is not clear from the claims themselves whether the "related" inventions are patentable over each other. Petitioners argue extensively that they are not and admit that the process of claims 8 and 9 differs from the prior art only by the recitation of the specific composition of matter recited in claim 5, and that the claimed process would be an obvious use of the claimed composition within the meaning of 35 USC 103.

In view of the Office policy with respect to restriction requirements set forth above, the closeness of the "patentably distinct" question, and Petitioners' clear and unambiguous admission that the inventions are not patentable over each other, it is concluded that the public interest is better served by withdrawing the restriction requirement and permitting both inventions to be prosecuted in the same application.

Accordingly, the decision of the Group Director of May 27, 1977 is reversed and the examiner is directed to withdraw the requirement for restriction and take action on the merits of the claims previously withdrawn from consideration.

[3] With respect to the second request, Petitioners argue that the term "independent and distinct", as found in 35 USC 121, is improperly interpreted by the Commissioner and request that instructions to examiners be revised to recite that inventions must be both "independent" and "distinct" to be properly restrictable. The arguments presented and authorities cited have been carefully considered. However, they are, with one exception, a restatement of the arguments of the prior petition. The exception is the discussion of the Pedersen case, wherein Petitioners argue that the court in Pedersen used the term "distinct" in the same sense that Steinmetz used the term "independent". A review of the claims in the Pedersen case render this interpretation unpersuasive. In Pedersen, the restriction was between a process and machine for carrying out the

process, on one hand, and the article produced on the other. Clearly, the article produced was related to both the process and machine. The process, machine and article produced were all "for the same common purpose and auxiliary to the same end", i.e. the production of the article. Therefore, the inventions were not "independent" as the term is used in Steinmetz, and yet the court upheld the requirement for restriction.

The other arguments presented were present in the original petition and thus were considered in reaching the decision of December 20, 1977. There is nothing in the present petition to indicate that the decision of December 20, 1977 was in error. Accordingly, the petition for reconsideration of the decision of December 20, 1977 is denied.

The application is being returned to Group 140 for further action in conformity with this decision.

In Summary:

The petition to withdraw the requirement for restriction is granted.

The petition to revise the Commissioner's instructions with respect to requirements for restriction generally is denied.

Commissioner of Patents and Trademarks

In re McDonald
Decided Mar. 9, 1978

PATENTS

1. Applications for patent — In general (§15.1)

Pleading and practice in Patent Office — In general (§54.1)

Provisional acceptance of application papers is warranted without condition in view of subsequent filing of original papers executed by applicant whose original application papers were airmailed to local counsel in ample time for normal delivery, but did not arrive before anniversary date of earlier-filed foreign application, and where photocopy of original declaration was sent separately and arrived in time for filing with copy of specification, and counsel who attempted without success to file

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